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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,588	02/09/2001	Richard Levy	01064.0011-07000	6816

7590 09/10/2004

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EXAMINER	
TOOMER, CEPHIA D	

ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/779,588	LEVY, RICHARD
	Examiner	Art Unit
	Cephia D. Toomer	1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 June 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *57-80* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *57-80* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This Office action is in response to the amendment filed June 17, 2004 in which claims 57, 58, 69 and 70 were amended and claims 81-85 were canceled.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 61-68 and 73-80 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 61, 62, 73 and 74 (and their dependent claims 63-68 and 75-80) lack support from the originally filed specification and claims for the limitations "substrate comprises a cable" (claims 61, 63, 65-68 and claims 73, 75 and 77-80) and "substrate comprises a wire" (claims 62 and 64-68 and claims 74 and 76-80).

Applicant argues that the specification supports these expressions "expressly, implicitly, or inherently." Applicant argues that pages 6-9 provide for lubricants, that page 12 provides for lubricants on cables, page 6 provides for lubricants on wires and that page 20 makes clear that the invention inter alia comprises the application of a "coating" of the disclosed superabsorbent polymer-lubricant

composition to a substrate as well as the article of manufacture obtained. Page 20 also describes applicant's use of related prior art lubricants specified at pages 6-19 in the superabsorbent polymer-lubricant composition.

A careful study and review of the instant specification indicate that the particularly selected descriptions at pages 6-9 and 12, is admitted prior art under the section of the background of the specification as to what is well-known and conventionally used in the lubricant art. The present invention is clearly directed to the lubricant composition. If Applicant had intended to use the composition to coat cables and wires, there would be some mention of these articles in the summary of the invention and perhaps the examples. However, the examiner does not find such recitations. The term "cables" only appears once in the entire 75 page specification and is referring to a polyisobutylene lubricants applied to cables. The term "wire" appears 11 times, once referring to solid lubricants and the other 10 times to the mixer used to prepare the composition.

3. Claims 67, 68, 79 and 80 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

4. The specification does not support a coating composition comprising a super absorbent polymer, a lubricant and optional lubricant additives wherein the additive is a binder. Applicant states that "there is a need for additional materials that will provide

the same advantage as those of the related as well as additional advantages and also materials that will overcome some of the various disadvantages of the related art. Nowhere in this recitation and any which precedes or follows it is there a recitation of combining a binder with the polymer and lubricant. The specification speaks to overcoming the disadvantages of the prior art and not to combining the prior art binders with the present invention.

Freeman teaches a gel composition comprising a gel matrix, a thickener (soaps) and a water absorbent polymer (see abstract). The gel matrix may be silicones, petroleum gels, high viscosity esters (fatty oils), glycol, olefins, mineral oil and fluorocarbons (see col. 7, lines 19-39). The water absorbent polymers include polyacrylic, maleic acids, acrylates, acrylamide and acrylonitrile (see col. 5, lines 55-68; col. 6, lines 1-29). The gel composition also contains a rust inhibitor (see col. 9, lines 26-35).

The gel composition is used to protect enclosed components or contents from water damage, such as cables and wires (see abstract; col. 3, line 65 through col. 4, lines 1-8). The thickeners are used to achieve a desired viscosity (see col. 8, lines 1-57). The gel composition also contains a tackifier or binding agent that helps bind the gel composition to the wire or cable (see col. 8, line 58 through col. 9, lines 1-25).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 57-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman (US 5,218,011) in view of Le-Khac (US 4616,063).

Freeman teaches a gel composition comprising a gel matrix, a thickener (metal stearate soaps) and a water anionic absorbent polymer (see abstract). The gel matrix may be silicones, petroleum gels, high viscosity esters (fatty oils), glycols, olefins, mineral oil and fluorocarbons (see col. 7, lines 19-39). The gel also contains a surfactant (see col. 7 lines 45-68). The water absorbent polymers include polyacrylic, maleic acids, acrylates, acrylamide and acrylonitrile (see col. 5, lines 55-68; col. 6, lines 1-29). The gel composition also contains a rust inhibitor (see col. 9, lines 26-35).

The gel composition is used to protect enclosed components or contents from water damage, such as cables and wires (see abstract; col. 3, line 65 through col. 4, lines 1-8). The thickeners are used to achieve a desired viscosity (see col. 8, lines 1-57). The gel composition also contains a tackifier or binding agent that helps bind the gel composition to the wire or cable (see col. 8, line 58 through col. 9, lines 1-25).

Freeman teaches that the gel matrix should provide a fairly uniform dispersal of the anionic polymer in the gel. Hence, Freeman teaches a dispersion.

Freeman does not specifically teach that the super absorbent polymers of his invention absorb greater than 100 times it weight in water and desorbs water when the coating is dried. In Example 22, Freeman teaches a composition comprising white oil (petroleum oil), micro-crystalline wax and a water absorbent polymer that is of the type

described in 4,616,063 (Le-Khac). Le-Khac teaches that the polymers of his invention have a water up take up to 16,000% (see Table, col. 6).

It would have been obvious to one of ordinary skill in the art to have used a polymer that absorbs greater than 100 times it weight in water because Le-Khac teaches that the polymers of Freeman have this capability. Freeman does not specifically teach that the polymers desorb water when the coating is dried; however, it would be reasonable to expect that polymers taught in Freeman would meet this limitation given that they are the same polymers or similar polymers as those of the present invention.

7. Applicant's arguments filed have been fully considered but they are not persuasive.

Applicant argues that Freeman fails to teach or suggest dispersions of materials for decreasing friction comprising a super-absorbent polymer and material for decreasing friction.

The examiner respectfully disagrees. Freeman teaches a gel composition wherein a super-absorbent polymer and a material that decreases friction are combined. In order to obtain a gel a dispersed phase and a continuous phase must be present. Therefore, since Freeman teaches a gel, Freeman meets the limitation regarding a dispersion.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cephia D. Toomer
Primary Examiner
Art Unit 1714

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